



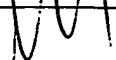
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,938	10/28/2003	Wai Hing Lai	016660-181	4311
21839	7590	11/16/2004		
BURNS DOANE SWECKER & MATHIS L L P				
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ALEXANDRIA, VA 22313-1404				
			EXAMINER	
			JEFFERY, JOHN A	
			ART UNIT	PAPER NUMBER
			3742	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/693,938	Applicant(s) LAI ET AL. 	
	Examiner John A. Jeffery	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 USC 102(b) as being anticipated by Whitefield (US 6,035,770). Whitefield (US 6,035,770) discloses an electric grill comprising a body member 14 supporting a grill plate 30, releasable cover 16, container 90 holding a smoking element (wood chips), and a first heating member comprising electric heating element 52 that heats the smoking element. The container is releasably engageable with the first heating member for replenishing the container. See Fig. 2-4 and col. 3, line 47 - col. 4, line 5.

Joint Inventors -- Common Ownership Presumed

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C.

103.

Claim Rejections - 35 U.S.C. § 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitefield (US 6,035,770) in view of Horton (US 3,517,602). The claim differs from the previously cited prior art in calling for a perforated cover releasably covering the container. But providing removable perforated covers for smoking containers is well known in the art as evidenced by Horton (US 3,517,602) noting removable grate 44. The perforated grate protects the underlying smoking material and heating element, yet permits smoke and heat to pass therethrough. See Fig. 2, 3, and col. 3, lines 20-25. In view of Horton (US 3,517,602), it would have been obvious to one of ordinary skill in the art to provide a perforated cover for the container in the previously described apparatus to protect the underlying smoking material and heating element, yet permit smoke and heat to pass therethrough.

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Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitefield (US 6,035,770) in view of Horton (US 3,517,602) and further in view of JP2001-104165. The claims differ from the previously cited prior art in calling for a fan drawing air from the cavity between the grill plate and the cover into the body member interior, and directing air back into the cavity after passing through a filter. Providing fans to create such an airflow, however, is conventional and well known in the art as evidenced by JP2001-104165 noting fan 12 that directs air into the interior of the body member, through filter 9, and back to the cavity between the grill plate and cover. Note airflow arrows in Fig. 1. Such an arrangement provides a recirculatory airflow path that filters undesirable odors from the cavity. In view of JP2001-104165, it would have been obvious to one of ordinary skill in the art to provide a fan creating a recirculatory airflow path in the previously described apparatus to that filter undesirable odors from the cavity.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitefield (US 6,035,770) in view of Giebel et al (US 5,719,377). The claim differs from the previously cited prior art in calling for a second heater to heat the grill plate. But providing independent heaters for the smoking container and grill plate respectively is well known in the art as evidenced by Giebel et al (US 5,719,377) who discloses an electric grill comprising first heater 16 that heats smoking material in container 18 and second heater 12 that heats grill plate 10. See Figs. 1, 2, and 5 and col. 4, lines 36-54. Such an arrangement enables independent temperature control of both the grill plate

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and the container heaters as desired. In view of Giebel et al (US 5,719,377), it would have been obvious to one of ordinary skill in the art to provide separate grill plate and container heaters in the previously described apparatus to enable independent temperature control of both the grill plate and the container heaters as desired.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/56196 in view of Wertheimer et al (US 3,714,885). WO 00/56196 discloses providing quartz tubes 3 as heat sources in electric grills to heat a container to produce smoke. Although WO 00/56196 does not specify that the quartz tubes that emit "bright red temperatures" are light sources, it is well known to use lamps as quartz tube infrared heat sources in grilling apparatus. Wertheimer et al (US 3,714,885), for example, teaches using a plurality of tungsten filament quartz tube lamps as the heat source. In view of Wertheimer et al (US 3,714,885), it would have been obvious to one of ordinary skill in the art to use lamps as the quartz tube heat source in the apparatus of WO 00/56196 to produce visible light as well as heat within the apparatus. Regarding claim 12, halogen lamps are conventionally used in radiant electric heaters and no criticality is seen in their use over quartz infrared heaters.

Allowable Subject Matter

Claim 10 is allowable over the art of record.

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Other Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should (1) separately consider the art, and (2) consider the art together with the previously cited prior art for potential applicability under 35 U.S.C. §§ 102 or 103 when responding to this action. US 632, US 526, US 748, US 882 disclose smoking apparatus relevant to the instant invention.

Response to Arguments

Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Final Rejection

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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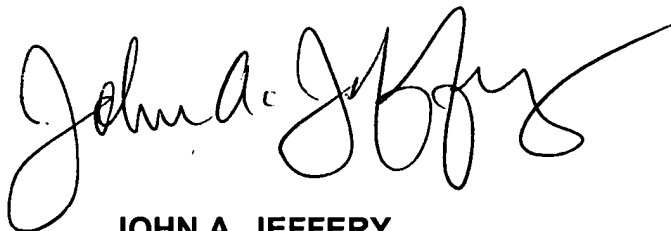
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (703) 306-4601. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (703) 305-5766. All faxes should be sent to the centralized fax number at (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

A handwritten signature in black ink, appearing to read "John A. Jeffery", with a stylized, flowing script.

**JOHN A. JEFFERY
PRIMARY EXAMINER**